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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,742	09/14/2001	Heinrich Jurgensen	P010032	5122

26574 7590 11/19/2003

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EXAMINER
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MENEFEE, JAMES A

ART UNIT	PAPER NUMBER
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2828

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/786,742

Applicant(s)

JURGENSEN, HEINRICH

Examiner

James A. Menefee

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112 rejection.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 337-421.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
PAUL IPSUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800

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### ATTACHMENT TO THE ADVISORY ACTION

Applicant's arguments filed 11/3/2003 have been considered but are not persuasive.

The argument that the amendments avoid the 35 U.S.C. § 112 rejections is persuasive.

Applicant argues that Pernick is not capable of eroding the processing surfaces as claimed and relies on three separate and independent arguments. Each of these will be discussed.

Applicant's first argument (pp. 19-20 of response) is not persuasive. The argument is that Pernick's system will not provide the necessary power sufficient for erosion, and that Pernick instead teaches away from erosion. The claims, however, require only that the laser beams have "a power density and energy sufficiently high to erode material from [a] processing surface for creating...cups." There is nothing that requires the processing material to be a certain type of material. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Since the claims do not require any particular material for the processing material, then the broadest interpretation of the claims is that the material may be any material. While Pernick does not teach erosion, and while the system of Pernick may not be powerful enough to erode the copper material of the specification, it is surely powerful enough to erode cups in *some* material. The applicant does not argue against any of the other reasoning of the Examiner's rejection, only against Pernick's ability to erode, and it is still believed that Pernick will be able to erode some processing material. The Examiner thus stands by the final rejection of the claims listed above as rejected.

Applicant's second and third arguments (pp. 20-23) are specifically drawn towards the claims that recite a printing form (claims 385, 406, 408, 409, 410, and 417-421). These

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arguments are not persuasive. Applicant's argument is based on the assertion that Pernick will not have the capability of eroding such a printing form as claimed. However, laser engraving and cutting are extremely well known in the prior art. Even if Pernick's laser system is not capable of engraving cups as claimed, one skilled in the art would have been able to use Pernick's system with lasers that are capable of engraving copper. Applicant's invention is drawn to a laser system for use in engraving a surface. The basic system is known, as shown in Pernick, and laser engraving tools are well known, thus one skilled in the art would combine lasers powerful enough for laser engraving with Pernick's system to provide a system that meets applicant's claims.

Claim 385 does not disclose any particular material for the printing form and the argument based on that claim is not persuasive for the same reason as the first argument.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Menefee whose telephone number is (703) 605-4367.

The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JM

November 13, 2003